

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-7, 12-20, and 22 were under examination at the time of the Action. Claims 28-30, 36-41, 46 and 47 were withdrawn. Claims 2, 5, 22, 37, 38, and 47 are canceled. Claims 1, 7, 14, and 36 are amended. Support for these amendments can be found at least on page 51-55 and in the claims as originally filed. No new matter has been added. Claims 1, 3, 4, 6, 7, and 12-20 are currently pending.

II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 7 and 22 are rejected as being indefinite under 35 U.S.C. §112, second paragraph. Claim 7 has been amended to include “the second antibody” in place of the objected phrase “the antibody.” Claim 22 has been canceled. Applicants request the withdrawal of the rejections.

III. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-2 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Burton *et al.* (US Patent 6,376,170, April 2002; IDS filed 12/19/2006). Claims 1-2, 12-16, 19-20, and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by Burton *et al.* (US Patent 6,156,313, 2000; IDS filed 12/19/2006). Claims 1-2, 12-16, 19, and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by Tso *et al.* (US Patent 5,932,448, 1999; IDS filed 12/19/2006)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131 citing

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The claims are currently directed to “A single chain antibody that specifically binds to an HSV glycoprotein D (HSV gD) and comprises light and heavy chain hypervariable regions of a monoclonal antibody DL11 or 1D3.” The cited references do not describe hypervariable regions from DL11 or 1D3.

IV. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-4, 12-16, 19-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton *et al.* (US Patent 6,156,313, 2000; IDS filed 12/19/2006) in view of Alvarez-Vallina *et al.* (Eur. J. Immunol.; 26:2304-2309, 1996). Claims 1-2, 5, 12-16, 19-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton *et al.* (US Patent 6,156,313, 2000; IDS filed 12/19/2006) in view of Nicola *et al.* (J. Virol., 72:3595-3601, 1998; IDS filed 12/19/2006). Claims 1-2, 12-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton *et al.* (US Patent 6,156,313, 2000; IDS filed 12/19/2006) in view of Hostetler *et al.* (US Patent 5,580,571, 1996). Claims 1-2, 6-7, 12-16, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso *et al.* (US Patent 5,932,448, 1999; IDS filed 12/19/2006).

A teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants note that obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 [68 USPQ2d 1940] (Fed. Cir. 2003)) and “a reason that would have

prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 [82 USPQ2d 1385] (2007).

The cited prior art references do not provide a teaching or suggestion of including the hypervariable regions of D11 or 1D3. Furthermore, these hypervariable regions give rise to the unexpected property of neutralizing HSV and preventing HSV infection. The references or the state of the art do not provide a reasonable expectation of achieving these results. Thus, the cited references do not teach or suggest all elements of the claimed invention nor do these references provide one of skill in the art a reasonable expectation of achieving a *in vivo* neutralizing single chain antibody. Applicants respectfully request withdrawal of the rejections.

V. CONCLUSION

Applicants believe that the present document is a full and complete response to the Action dated January 2, 2009. The present case is in condition for allowance, and such favorable action is respectfully requested.

The Examiner is invited to contact the undersigned Attorney at (512) 536-3167 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



Charles P. Landrum
Reg. No. 46,855
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Ave., Suite 2400
Austin, Texas 78701
(512) 536-3167
(512) 536-4598 (facsimile)

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